

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/671,924
Applicant : Andrew S. Poulsen
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TC/A.U. : 2476
Examiner : Moutaouakil, Mounir
Docket No. : 10021064-01

Confirmation No. 8482

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

This "Second" Pre-Appeal Brief is filed in response to the Final Office Action mailed October 28, 2009. Claims 1-12 and 14-25 remain in the application, all of which stand rejected. Claim 13 was previously canceled.

Claim 1-12 and 14-25 stand rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner asserts that the specification does not contain sufficient information to enable the recitation of "an electronic test instrument". The Examiner further states:

. . . The specification does not explain what is the test instrument, what does the test instrument do, what is being tested, how does the test instrument generate the instrument data, what is the purpose [of] the test instrument and who will benefit from the tests generated.

10/28/2009 Final Office Action, p. 2.

To begin, applicant notes MPEP 2164.01, which states:

. . . The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: ***is the experimentation needed to practice the invention undue or unreasonable?*** That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that

the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

(Emphasis added)

In the present application, applicant believes it clear that **the invention** is not a new kind of electronic test instrument *per se*, but rather an instrument system that comprises, in combination, an electronic test instrument and a network interface module, with a particular relationship therebetween. Applicant's specification is replete with description of how the electronic test instrument and network interface module are related; how instrument data is passed therebetween; how voice and instrument data are combined and separated by the network interface module; how the network interface module can be used to obtain remote diagnostic and support help for the electronic test instrument; etc. In this context, applicant fails to understand how their specification would not **enable** one of ordinary skill in the art to make and use **the invention**.

With respect to the Examiner's specific questions regarding the claimed "electronic test instrument", applicant asserts that his electronic test instrument performs tests, which tests are useful to (or benefit) the operator or engineer that uses the electronic test instrument (*see, e.g., p. 6, lines 8-9*). However, contrary to the Examiner's assertions, applicant does not believe he needs to provide more detailed answers to the questions posed on page 2, par. 4, of the 10/28/2009 Final Office Action,

because applicant's specification already enables one of ordinary skill in the art to make and use the "invention".

Withdrawal of any claim rejections under 35 USC 112 is respectfully requested. If the Office persists in maintaining claim rejections under 35 USC 112, applicant believes the Examiner needs to specifically indicate why "undue experimentation" is required to practice applicant's claimed invention. In particular, applicant believes the Examiner to address the "undue experimentation factors" enumerated by *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), which factors are summarized in MPEP 2164.01(a). The Examiner has not addressed any of these factors, and applicant respectfully believes it is clear error not to do so.

Claims 1-12 and 14-24 stand rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413). With respect to claim 1, the Examiner admits that Loveland fails to disclose an "electronic test instrument", but he asserts that it is well known that computers can test networks. See, 10/28/2009 Final Office Action, p. 4. However, the Examiner has not made a case for why it would have been obvious to specially configure one of the computers disclosed in Loveland as an "electronic test instrument". Absent such a showing, applicant does not believe the Examiner has made a prima facie case for rejecting claim 1, and claim 1 is believed to be allowable.

In the Final Office Action mailed 10/28/2009, the Examiner responded to the above argument by 1) asserting that claims are interpreted broadly and limitations recited in the specification are not to be read into the claims, and 2) asserting that because applicant did not traverse the Examiner's "official notice that it is well known and preferred in the art the [sic] computers can test the network by sending packets, ping and traceroute commands to test the network [sic]", this well known information was taken as admitted prior art. See, 10/28/2009 Final Office Action, p. 10. Regarding the Examiner's first assertion, applicant fails to understand how this is relevant, because applicant has not argued that recitations in his specification be read into his claims. Instead, applicant has only urged that the phrase "electronic test equipment" be given meaning. The phrase "electronic test equipment" is clearly *in the claims*. Regarding the

Examiner's position regarding what is admitted prior art, applicant readily admits that computers can be used to test networks. Applicant's arguments have never contested this. Applicant's arguments have, however, noted that the Examiner has never made a case for why it would have been obvious to a PHOSITA to specially configure one of the computers disclosed in Loveland as an "electronic test instrument". And, assuming for a moment that such a case could be made (which applicant believes it cannot), the Examiner has not made a case for why it would have been obvious to combine any sort of "instrument data" coming from one of Loveland's reconfigured computers with "voice data" coming from one of Loveland's phones.

MPEP 2141 indicates that an Examiner must support an obviousness determination by first determining the scope and content of the prior art, then ascertaining the differences between the claimed invention and the prior art, then resolving the level of ordinary skill in the art, and finally by providing a "rationale" to support a rejection under 35 USC 103. MPEP 2141.III states, in part:

The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious. The Supreme Court in **KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.** The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that **"[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

(Emphasis added)

In the present context, the Examiner has not made explicit (or even implicit) any sort of rationale (or reason) as to why a PHOSITA would have found it obvious to replace or reconfigure one of Loveland's computing devices 30 as a "test instrument". As such, the Examiner has not established a prima facie case of obviousness, and the burden of establishing otherwise has not shifted to applicant. However, despite applicant believing that he does not yet bear the burden of rebutting the Examiner's

prima facie case (which case has not yet been made), applicant notes that Loveland makes no mention of "test" or "testing".

To the extent the Examiner has taken official notice of the obviousness to replace or reconfigure one of Loveland's computers 130 as an electronic test instrument, *and then* combine instrument data from the electronic test instrument with voice data, applicant traverses this official notice and asks the Examiner to prove that such a combination would have been well known at the time of applicant's invention.

Claim 1 is believed to be allowable for at least the above reasons. Claims 2-10, 14-16 and 18-23 are believed to be allowable, at least, because each of these claims ultimately depends from claim 1.

Claims 5 and 10 are believed to be further allowable over claim 1. More specifically, Loveland does not teach a voice module that is built into the chassis of an electronic test instrument. At best, Loveland discloses 1) a computing device 130 that receives data, and 2) a separate telephone 137 that receives voice data. In response to the Examiner's assertion that building a voice module into the chassis of an electronic test instrument is simply "a matter of design choice" and has no particular purpose, applicant asserts that one purpose is to better integrate remote on-line support for the instrument (*see, e.g.,* p. 6, lines 4-12).

Claim 25 stands rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413) in view of Lashley et al. (US Patent No. 7,003,085; hereinafter "Lashley"). Claim 25 is believed to be allowable, at least, for reasons similar to why claim 1 is believed to be allowable, and because Lashley fails to disclose that which is missing from Loveland.

In light of the remarks provided herein, applicant respectfully requests the issuance of a Notice of Allowance.

Respectfully submitted,
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